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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.

Plaintiff,

v.

GOOGLE INC.

Defendant.

Case No. CV 10-03561 WHA

**ORACLE'S OPPOSITION TO
MOTION IN LIMINE RE
EVIDENCE ALLEGEDLY
SUPPORTING KNOWLEDGE
REQUIREMENT FOR
INDIRECT INFRINGEMENT**

Dept.: Courtroom 8, 19th Floor
Judge: Honorable William H. Alsup

1 Oracle America, Inc. opposes Google's motion *in limine* to exclude certain deposition
2 testimony of Mr. Andy Rubin (Dkt. 1078).

3 INTRODUCTION

4 Oracle designated deposition testimony by Mr. Rubin showing that (1) Mr. Rubin was
5 aware that Sun had Java-related patents, (2) Mr. Rubin had discussions with Sun about licensing
6 those patents for Android, and (3) Mr. Rubin and Google, after failing to obtain a license from
7 Sun, deliberately avoided investigating whether Android would infringe any of those Java-related
8 patents. Mr. Rubin's testimony is highly relevant to the issues that the jury must decide in
9 Phase 2, including whether Google should be held liable for indirect patent infringement based on
10 its "willful blindness" of Sun's patents.

11 In Phase 2, Oracle intends to present substantial evidence – including but not limited to
12 the deposition testimony of Mr. Rubin – demonstrating that Google both had actual knowledge of
13 Sun's patents and that Google was "willfully blind" with respect to Android's infringement of
14 those patents. That evidence will include the fact that Mr. Tim Lindholm, who was a Project
15 Advisor for Android (TX 6 at p. 7), was one of the authors of the "The Java Virtual Machine
16 Specification" book that specifically referred to a predecessor of the '104 patent. (TX 25 at
17 p. 389.) Furthermore, in 2005 and 2006, Mr. Rubin sought to negotiate an agreement with Sun
18 that would have specifically covered Sun's patents, and would have provided a license for
19 Android. (TX 618 at p. 9-10.) This is not a case where an unknown company later claims
20 infringement. Google knew of Sun's patents and sought a license that would have covered the
21 '104 and other patents. Mr. Rubin's deliberate failure to take any steps to evaluate whether
22 Android would infringe those patents is very relevant to proving Google's knowledge and
23 willfulness.

24 There is no basis to exclude Mr. Rubin's testimony. That testimony, along with the other
25 evidence that Oracle has offered and will offer in Phase 2, is relevant to prove Google's
26 knowledge and willful disregard of Sun's and now Oracle's intellectual property rights. There is
27 no risk of confusion or prejudice to Google, but it would be prejudicial to Oracle to prevent the
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1 jury from hearing such testimony from Mr. Rubin, who is in charge of Android. Google's motion
2 should be denied.

3 **ARGUMENT**

4 In *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2069 (2011), the Supreme
5 Court held: "Given the long history of willful blindness and its wide acceptance in the Federal
6 Judiciary, we can see no reason why the doctrine should not apply in civil lawsuits for induced
7 patent infringement under 35 U.S.C. § 271(b)." The Supreme Court articulated two basic
8 requirements for willful blindness: "(1) the defendant must subjectively believe that there is a
9 high probability that a fact exists and (2) the defendant must take deliberate actions to avoid
10 learning of that fact." *Id.* at 2070. Lower courts have already applied the Global Tech willful
11 blindness standard as an alternative to direct knowledge for proving indirect infringement. *See*
12 *McRee v. Goldman*, No. 11-CV-00991-LHK, 2012 U.S. Dist. LEXIS 36793 (N.D. Cal. Mar. 19,
13 2012); *Dataquill Ltd. v. High Tech Computer Corp.*, No. 08cv543-IEG, 2011 U.S. Dist. LEXIS
14 138565 *27 (S.D. Cal. Dec. 1, 2011) ("the Supreme Court explained that under this standard
15 actual knowledge is not required, and that the intent may be shown under the willful blindness
16 doctrine"); *Fred Hutchinson Cancer Research Ctr. v. Branhaven, LLC*, 2012 U.S. Dist. LEXIS
17 46990 *5 (E.D. Va. Apr. 2, 2012) (citing *Global-Tech* for holding that induced infringement
18 under § 271(b) "requires knowledge, or willful blindness, that the induced acts constitute patent
19 infringement") (emphasis added).

20 Sections 271(b) and 271(c) share the same knowledge requirement, and the Court's
21 reasoning indicates that they must share willful blindness as well. Other courts agree. *See, e.g.,*
22 *Trading Techs. Int'l, Inc. v. BCG Partners, Inc.*, No. 10 C 715, 2011 U.S. Dist. LEXIS 99415, at
23 *13 (N.D. Ill. Sept. 2, 2011) ("As noted above, in *Global-Tech* the Supreme Court established
24 that the plaintiff must show the alleged infringer must have knowledge of the patent at issue (or at
25 least 'willful blindness' to the patent) and knowledge that the infringer's product infringed on that
26 patent to prove a claim for contributory infringement (35 U.S.C. § 271(b)) and inducing
27 infringement (35 U.S.C. § 271(c)).").
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1 Mr. Rubin's testimony is relevant to establishing Google's willful blindness, and there is
 2 no basis to exclude that testimony. The testimony that Google seeks to exclude includes the
 3 following points:

- 4 • When questioned about the negotiations with Sun, Mr. Rubin testified that he
 5 recalled "some discussions around patents. ... there was a notion of a partnership
 6 where we could actually license both technology, implementation, and patents,
 7 where the patents would be used to protect the open platform." (4/5/2011 Rubin
 8 Tr. at 111:12-112:5.)
- 9 • When questioned about an email where Mr. Rubin referred to the fact that Sun
 10 owned patents, in connection with a Java-related announcement, Mr. Rubin
 11 testified: "I assume they're running a business, they're inventing intellectual
 12 property, they're protecting it through the patent system. Through GPL, I didn't
 13 know what they were, but I knew that it was dangerous to use the stuff without
 14 knowing exactly what it was." (7/27/2011 Rubin Tr. at 13:5-9, 16:4-16.)
- 15 • Despite those discussions with Sun and his awareness of Sun owning Java-related
 16 patents, Mr. Rubin testified that he "never investigated the breadth of Sun's
 17 portfolio" and never conducted any review of Sun's or Oracle's patents as they
 18 related to Android. (7/27/2011 Rubin Tr. at 8:14-9:4; 19:8-20; 20:5-15; 26:5-23.)
- 19 • When questioned about an email in which he wrote that Sun "threatened to sue us
 20 over patent violations," Rubin testified, contrary to what he wrote in the email, "I
 21 don't think Sun ever threatened to sue us over patent violations." (4/5/2011 Rubin
 22 Tr. at 28:5-30:1, 30:13-24.)

23 This testimony, along with the other evidence that is already in the record and evidence
 24 that will be offered in Phase 2, demonstrates that Google knew of Sun's patents but decided to
 25 proceed without a license. In July 2010, Oracle informed Google that Android infringed the '104
 26 and '520 patents. One month later, Mr. Lindholm wrote that Google needed a Java license from
 27 Oracle for Android. (TX 10.) Given Mr. Lindholm's familiarity with the technology covered by
 28 the '104 patent, it is a reasonable inference that Mr. Lindholm was referring at least in part to that
 patent when he wrote that Google needed a license from Oracle. The designated testimony by
 Mr. Rubin's is consistent with this other evidence, and should not be excluded. Excluding
 Mr. Rubin's testimony at this stage would be both premature and prejudicial to Oracle.

Mr. Rubin oversaw the development of Android, and he and others repeatedly referred to
 the "JVM" or "Java Virtual Machine" that Google was developing for Android. Before Google

1 even acquired Android, Mr. Rubin made a presentation in which he stated that Android planned
2 to include a “JVM” that would be based on “Java licensed from Sun, mods by Android.” (TX 4
3 at p. 28.) After Google acquired Android, in presentations and emails to Google’s top executives,
4 Mr. Rubin repeatedly referred to the “JVM” that the Android team was working on. (TX 1 at
5 p. 9; TX 3 at p. 2; TX 6 at p. 11; TX 7 at p. 1.) Google employees stated in internal emails that
6 “the JVM is going to be a central piece of the system we’re building” and that “the JVM is core to
7 our platform architecture and strategy.” (TX 5 at p. 3; TX 20 at p. 1.) Google employees also
8 acknowledged in internal documents that the license from Sun was “critical” for Android.

9 (TX 17 at p. 1.) After Google was unable to negotiate any deal with Sun that would provide that
10 critical license, Google decided to move forward anyways. Even then, Mr. Rubin and others
11 continued to refer to the virtual machine that they were working on as a “JVM.” (TX 151 at p.
12 5.) There were extensive negotiations between Google and Sun, and Mr. Rubin’s plan all along
13 was to build a Java-based platform with a high-performance JVM. That was exactly what he had
14 done at Danger, and what Mr. Rubin wanted to do at Google. Mr. Rubin recognized early on that
15 one option was to proceed without a license and risk making “enemies.” (TX 7 at p. 2.)
16 Mr. Rubin’s admissions that he did nothing whatsoever to evaluate what Sun patents Google
17 might infringe with Android is not only relevant but strong evidence of Google’s willfulness.

18 Google cites *Apeldyn Corp. v. AU Optronics Corp.*, Civ. No. 08-CV-568-SLR, 2011 U.S.
19 Dist. LEXIS 134759 (D. Del. Nov. 15, 2011), but that decision provides no basis to exclude
20 Mr. Rubin’s testimony. In *Apeldyn*, the court cited quoted *Global-Tech*: a “willfully blind
21 defendant is one who takes deliberate actions to avoid confirming a high probability of
22 wrongdoing and who can almost be said to have actually known the critical facts.” *Id.* at *29.
23 There, in stark contrast to this case, the *only* evidence cited by the court was testimony that the
24 defendant would generally not review patents issued to other companies unless there was a
25 request from the internal lawyers to do so. *Id.*

26 Here, unlike in *Apeldyn*, there were years of negotiations between Google and Sun leading
27 up to Google’s release of Android, and the evidence presented during Phase 2 will demonstrate
28 that those negotiations focused on Sun’s patents. Google employees at various times referred to a

1 license from Sun as “critical” for Android (TX 17), and Mr. Rubin made a presentation to
2 Google’s very top management regarding the deal with Sun in which he indicated that the deal
3 would result in “patent grants” by Sun for Android (TX 22 at p. 9). After launching Android,
4 Google considered buying “the rights to Java from Sun (patents, copyrights, etc)” in part because
5 the result would be “Our Java lawsuits go away.” (TX 326 at p. 2-3.) From the very beginning,
6 Google sought a license to use Sun’s patented technology. Google then proceeded to distribute
7 Android to manufacturers without any license, knowing that Sun could sue. Google’s actions,
8 and Mr. Rubin’s testimony, evidence an active intent to induce infringement by others.

9 Ultimately, Google is seeking to exclude Mr. Rubin’s testimony and other evidence
10 because that evidence is fundamentally inconsistent with the story that Google wants to tell the
11 jury. The parties exchanged openings, and Google’s opening includes the following assertion:
12 “Google independently developed Android not knowing of the Sun patents.” That assertion is
13 false, and the testimony by Mr. Rubin – and the trial testimony of Mr. Lindholm – is relevant to
14 showing that any lack of knowledge was based on Google’s deliberate decision to proceed
15 without any investigation, knowing that it might make “enemies” doing so, and that it would
16 eventually face “Java lawsuits.”

17 Google’s final argument is that Mr. Rubin’s testimony should be excluded because that
18 testimony would not suffice to show that Google “intended to induce infringement of the patent,
19 which in turn requires knowledge that the induced acts constitute infringement.” (Dkt. 1078 at
20 p. 5.) There are two flaws with this argument.

21 First, there is no requirement that Mr. Rubin’s testimony in itself establish each and every
22 element of Oracle’s claims. Google seeks exclusion on the basis that Mr. Rubin’s testimony is
23 “insufficient to prove an element of its [Oracle’s] case” (Dkt. 1078 at p. 5), but that is not the
24 question on this motion. The only question on this motion is whether Mr. Rubin’s testimony is
25 relevant to *any* of the issues in Phase 2, and if so whether it should nonetheless be excluded under
26 Rule 402 or 403. As explained above, Mr. Rubin’s testimony is relevant to proving willful
27 blindness. There is no risk of confusion of prejudice with that testimony. Whether that testimony
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1 proves some other element is immaterial, and provides no basis to exclude this otherwise relevant
2 testimony.

3 Second, Google's argument is nothing more than an untimely and meritless attempt to
4 seek judgment as a matter of law on Oracle's inducement claim. Google's argument focuses less
5 on the designated testimony and more on the legal standard for proving inducement. Under
6 Google's proposed standard, an inducement claim would fail in every case where the parties
7 "hotly contest" infringement. (Dkt. 1078 at p. 5.) Google contends that it could not even be
8 liable for inducing infringement after July 2010, when Oracle specifically identified the '104 and
9 '520 patents. That is not the law. Regardless, Oracle will offer evidence showing that Google
10 knew of the '104 patent but nonetheless enabled and encouraged the broad adoption of Android
11 by handset manufacturers.

12 Oracle also opposes Google's motion on the basis that it is procedurally improper, leading
13 to unnecessary briefing. The Court's Jury Trial Guidelines establish a process for designating and
14 objecting to deposition testimony. For Mr. Rubin's testimony, the parties followed the Court's
15 procedure up to the point when Google announced at 3 pm today that it would be filing this
16 motion *in limine*. Google had already served its objections and counter-designations, and the next
17 step according to the Court's rules was for Oracle to evaluate those objections, to "meet and
18 confer as reasonable," and for Oracle to then "provide the Court with the final packet, with any
19 objected-to portions highlighted and annotated" as required by the Court's rules. The parties used
20 the Court's required procedures for all deposition testimony played during Phase 1, and Oracle
21 sees no reason to change that now.

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CONCLUSION

The evidence that will be presented in this next phase, including the testimony of Mr. Rubin, clearly fit the standard set in *Global-Tech* and other decisions regarding indirect patent infringement. There is no basis to exclude Mr. Rubin's testimony, and Oracle therefore requests that the Court deny Google's motion.

Dated: May 6, 2012

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